

**THOMAS R. FITZGERALD
PATENT ATTORNEY
REYNOLDS ARCADE BUILDING
16 EAST MAIN STREET • SUITE 210
ROCHESTER, NEW YORK 14614**

Voice: (585) 454-2250 • Fax: (585) 454-6364
e-mail: trfitz@rochester.rr.com

FACSIMILE TRANSMITTAL SHEET

****PLEASE HAND-CARRY TO:****

Examiner Richard J. Lee

Art Unit 2613

US Patent and Trademark Office

Fax: (703) 872-9314

From: Thomas R. FitzGerald, Esq.

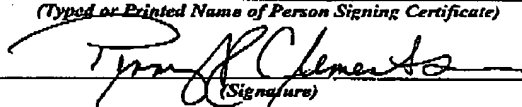
Date: April 24, 2003

Re: U. S. Ser. No. 08/800,574 filed February 18, 1997 July 2, 2002

Comments:

Attached is our Request for Reconsideration in the above matter.

Number of pages in this transmission (incl. cover sheet): 20

Serial No.		Filing Date	Examiner	Group Art Unit
08/800,574		February 18, 1997	Richard J. Lee	2613
Invention: NARROWBAND VIDEO CODEC				
<p>I hereby certify that this <u>Request for Reconsideration with attached Appeal Brief (18 pages)</u> (Identify type of correspondence)</p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>(703) 872.9314</u>)</p> <p>on <u>April 24, 2003</u> (Date)</p> <p><u>Penny P. Clements</u> (Typed or Printed Name of Person Signing Certificate)</p> <p><u></u> (Signature)</p> <p>Notes: Each paper must have its own certificate of mailing.</p>				

P18/REV01

FILE ORDERING
order patent files results

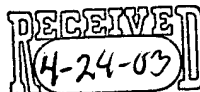
P Thursday
4/24/03
1:43:26 PM
WFO1003PR

Serial# **08/800574** File order accepted

Place another order

Butt

Official



Docket:
90041.97R074 (CSD-55)

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	Robert K. Riffce)	Examiner:
)	Lee,
Serial No.:	08/800,574)	Richard J.
)	
Filed:	February 18, 1997)	Art Unit:
)	2613
For:	NARROWBAND VIDEO CODEC)	

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Applicants requests reconsideration and withdrawal of the Notice of Abandonment. In an office action mailed April 17, 2003, the above application was held abandoned for failure to explain why the claims were separately patentable in the Brief on Appeal. Applicant submits that the Brief does argue for the patentability of each claim or group of claims.

In order to assist the Examiner, the table below shows where the claims are argued in the Brief. Certain claims stand or fall together including a first group of claims 1, 3, 6, 7 and 8, a second group of claims 19-28 and a third group of claims 29 and 30. Attached is a copy of the Brief with consecutive line numbers. The table below shows where each claim or group of claims is argued.

1, 3, 6, 7, 8	Lines 141-175
2	Lines 177, 178
4	Lines 180-184
5	Lines 186-189
9	Lines 191-198
10	Lines 191-198
11	Lines 191-198

00003293.DOC

12	Lines 191-198
13	Lines 191-198
14	Lines 191-198
15	Lines 191-198
16	Lines 191-198
17	Lines 191-198
18	Lines 191-198
19-28	Lines 209-237
29, 30	Lines 209-237

For each of the groups of claims that stand or fall together, the Brief has one or more arguments for each group. There is no question that lead claims 1, 19 and 29 of each group are argued. Likewise, there is no question that claims 2-5 are each individually argued. The only possible basis for the abandonment is Applicant's arguments for claims 9-18. Those claims are discussed together in lines 191-198. The argument for each claim is the same: its individual limitations are not shown or suggested in the prior art. That argument applies to each claim. As such the claims are jointly and individually argued because the same argument applies to each claim.

Applicants point out that the rejection of claims 9-18 admitted that the particular limitations of each of claims 9-18 are not shown in a prior art references. That admission is a common ground for the appeal of those claims.

A common rejection often results in an appellant grouping the commonly rejected claims for appeal. However, a common ground for rejection does not require the appellant to admit that the claims stand or fall together. Likewise, a common argument for a set of rejected claims does not mean, *ipso facto*, that the claims are not individually argued.

The MPEP at page 1200-10 states, in pertinent part, that if an appealed *ground* of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c) (7) requires appellant to state that the claims do not stand or fall together and to present the reasons why they are separately patentable. Absent such a reservation, if one claim is unpatentable for any reason, the other claims may fall with it.

Here the applicant stated that the common rejection was erroneous and presented a common argument for the patentability of each claim: the rejection must show the limitation in some reference before rejecting the claim. The claims do not stand or fall together because the limitations in one claim, even if unpatentable, would not necessarily render the other claims unpatentable. The rejection found none of the limitations of any of the claims 9-18 and so the claims are, in effect, jointly and severally patentable over the erroneous grounds of rejection and over the art of record.

Stated another way, suppose there is one claim with ten limitations. A final rejection finds four of the ten limitations in two references, A and B, and states that the other six limitations are obvious but cites no reference showing any of the six. Appellants could disagree with the grounds for rejection by saying that the rejections should show the six limitations in one or more references. The appellants could also point to each limitation, one at a time, and say it was not shown in a reference. The end result would be the same but it is more efficient (and briefer) to say that none of the art shows the six limitations. To require that the applicant to redundantly put into words the same argument for each reference would be an exercise of form over substance.

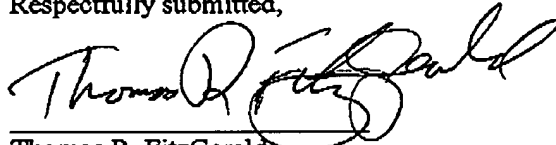
Here the claims are rejected for the same reason: the number of bytes and byte sequence are obvious and not critical. Applicants disagree with the premise of the rejection. Applicants assert that before one can reject a claim as obvious, one must find the limitation in the art of record. The rejection found none of the limitations of claims 9-18 in the art of record. As such, the same argument applies for each of claims 9-18 for each reference.

The claims 9-18 do not stand or fall together because even if one of the limitations were to be found in the prior art (and thereby form a proper basis for rejecting one of the claims) the other claims would not fall because Applicant then would have a right to distinguish the limitations not found from the limitations that are found.

00003293.DOC

In summary, if the holding of abandonment is based on no separate argument for each of claims 9-18, then the holding is in error. The claims are each individually argued because they were all rejected for the same erroneous reason. The one argument in lines 191-198 applies to each of claims 9-18.

Respectfully submitted,



Thomas R. FitzGerald
Reg. No. 26,730

Thomas R. FitzGerald, Patent Attorney
16 E. Main Street, Suite 210
Rochester, New York 14614-1803
Telephone: (585) 454-2250
Fax: (585) 454-6364

00003293.DOC